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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,263	12/31/2001	Joseph T. Pallante	01-40164-US	6175
7590	11/30/2005		EXAMINER	
Louis M. Heidelberg, Esq. Reed Smith LLP 2500 One Liberty Place 1650 Market Street Philadelphia, PA 19103			WINTER, JOHN M	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 11/30/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,263

Applicant(s)

PALLANTE, JOSEPH T.

Examiner

John M. Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24 and 35-116 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24,35-40,42,43,51-71,79-97 and 106-114 is/are rejected.
- 7) ☒ Claim(s) 41, 44-50, 72-78, 98-105 115,116 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

STATUS

Claims 24, 35-116 remain pending.

Response to Arguments

The applicant's arguments entered on September 21, 2005 have been fully considered. The examiner submits that the amended claims are rejected in view of the reconsideration of Graham et al (US Patent 6,625,267) in view of Downs et al.(US Patent 6,574,609). See following rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 35-40,42,43,51-71,79-97 and 106-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graham et al (US Patent 6,625,267) in view of Downs et al.(US Patent 6,574,609).

As per claim 24,

Graham et al. discloses a method for providing transactional billing for trusted third party services offered to a plurality of users via a computer networks said method comprising:

parsing said log records to generate billing information (Column 7, lines 31-41)

providing said billing information to at least one processing application which processes said billing information and generates a plurality of bills dependently thereupon, (Column 9, lines 23-42)

Graham et al. does not specifically disclose generating at least one log record indicative of at least one of said users submitting at least one electronic document for trusted third party service's; generating at least one log record indicative of forwarding said at least one electronic document to at least a second of said plurality of users, wherein said at least one electronic document is submitted via said computer network, Downs et al. discloses generating at least one log record indicative of at least one of said users submitting at least one electronic document for trusted third party services (Abstract) generating at least one log record indicative of forwarding said at least one electronic document to at least a second of said plurality of users, wherein said at least one electronic document is submitted via said computer network,(Column 8, lines 31-39)

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. It would have been obvious at the time the invention was made to combine the Graham et al. method with the Downs et al method in order to profile system usage by user

Claims 35, 68, and 91 are in parallel with claim 24 and are rejected for at least the same reasons.

As per claim 36,
Graham et al. discloses the computer program product of Claim 35, said code further comprising
code for capturing information indicative of a billing label from said first user, wherein at least some of said captured information is included in at least one of said log records. (Column 7, lines 31-41)

Claim 95 is in parallel with claim 36 and are rejected for at least the same reasons.

As per claim 37,
Graham et al. discloses the computer program product of Claim 36, wherein said billing label is associated with at least said submitting. (Column 9, lines 6-11)

Claim 69 is in parallel with claim 37 and are rejected for at least the same reasons.

As per claim 38,
Graham et al. discloses the computer program product of Claim 36, wherein said billing label is indicative of a client identifier. (Column 9, lines 6-11)

Claims 42, 70, and 96 are in parallel with claim 38 and are rejected for at least the same reasons.

As per claim 39,
Graham et al. discloses the computer program product of Claim 36, wherein said billing label is indicative of a credit card. (Column 9, lines 6-11)

Claims 43, 71, and 97 are in parallel with claim 39 and are rejected for at least the same reasons.

As per claim 40,
Graham et al. discloses the computer program product of Claim 36, wherein said Code further comprising
code for capturing information indicative of a billing label from user, wherein at least some of said captured information is included in at least one of said log records. (Column 7, lines 42-65)

Graham et al. discloses the claimed invention except for "second user ", It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a

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second user, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As per claim 51,
Graham et al. discloses the computer program product of Claim 35,
wherein said users are separated into a plurality of subsets, each of said subsets being associated with a subscribing entity. (Column 9, lines 6-11)

As per claim 52,
Graham et al. discloses the computer program product of Claim 51,
wherein at least one said subscribing entity is a firm.(Column 9, lines 6-11)

As per claim 53,
Graham et al. discloses the computer program product of Claim 51,
Further comprising providing at least one of said plurality of bills to at least one of said subscribing entities.(Column 9, lines 49-64)

As per claim 54,
Graham et al. discloses the computer program product of Claim 53,
wherein said at least one electronic document and said at least one of said plurality of bills are respectively submitted and provided via said computer network.(Column 9, lines 23-38)

Claim 106 is in parallel with claim 54 and are rejected for at least the same reasons.

As per claim 55,
Graham et al. discloses the computer program product of Claim 53,
wherein said at least one of said plurality of bills is provided via said computer network.(Column 9, lines 23-38)

Claim 79 is in parallel with claim 55 and are rejected for at least the same reasons.

As per claim 56,
Graham et al. discloses the computer program product of Claim 35,
said code further comprising code for storing data indicative of default billing information for each of said users.(Column 9, lines 6-22)

Claims 80 and 107 are in parallel with claim 56 and are rejected for at least the same reasons.

As per claim 57,
Graham et al. discloses the computer program product of Claim 35,
wherein said at least one electronic document is submitted via said computer network.(Column 9, lines 23-38)

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Claims 81 and 108 are in parallel with claim 57 and are rejected for at least the same reasons.

As per claim 58,

Graham et al. discloses the computer program product of Claim 35,

Graham et al. does not specifically disclose computer network comprises a global interconnection of computers and computer networks, Downs et al. discloses computer network comprises a global interconnection of computers and computer networks,(Figure 1C) . It would have been obvious at the time the invention was made to combine the Graham et al. method with the Downs et al method in order to provide inexpensive communication means.

Claims 82 and 109 are in parallel with claim 58 and are rejected for at least the same reasons.

As per claim 59,

Graham et al. discloses the computer program product of Claim 35,

Graham et al. does not specifically disclose code for generating a log record indicative of storing said at least one submitted electronic document, Downs et al. discloses code for generating a log record indicative of storing said at least one submitted electronic document,(Abstract) . It would have been obvious at the time the invention was made to combine the Graham et al. method with the Downs et al method in order to profile consumer spending trends.

Claims 83 and 110 are in parallel with claim 59 and are rejected for at least the same reasons.

As per claim 60

Graham et al. discloses the computer program product of Claim 59,

Graham et al. does not specifically disclose further comprising code for encrypting said submitted electronic document prior to said storing, Downs et al. discloses further comprising code for encrypting said submitted electronic document prior to said storing (Abstract) . It would have been obvious at the time the invention was made to combine the Graham et al. method with the Downs et al method in order to improve the security of the system.

Claims 84 and 111 are in parallel with claim 60 and are rejected for at least the same reasons.

As per claim 61,

Graham et al. discloses the computer program product of Claim 60,

Graham et al. does not specifically disclose further comprising code for generating a log record indicative of retrieving said encrypted stored electronic document, Downs et al. discloses further comprising code for generating a log record indicative of retrieving said encrypted stored electronic document,(Figure 1C) . It would have been obvious at the time the invention was

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made to combine the Graham et al. method with the Downs et al method in order to profile consumer spending trends.

Claims 85, 92-94 and 112 are in parallel with claim 61 and are rejected for at least the same reasons.

As per claim 62,

Graham et al. discloses the computer program product of Claim 61,

Graham et al. does not specifically disclose said code further comprising code for decrypting said encrypted retrieved electronic document, Downs et al. discloses said code further comprising code for decrypting said encrypted retrieved electronic document, (Figure 1D). It would have been obvious at the time the invention was made to combine the Graham et al. method with the Downs et al method in order to profile consumer spending trends.

Claims 86, 113 and 114 are in parallel with claim 62 and are rejected for at least the same reasons.

As per claim 63,

Graham et al. discloses the computer program product of Claim 35,

wherein said billing application comprises a commercially available billing application. (Column 2, lines 28-39)

Claim 87 is in parallel with claim 63 and are rejected for at least the same reasons.

As per claim 64,

Graham et al. discloses the computer program product of Claim 35, wherein said billing information is provided to said processing application electronically. (Column 9, lines 38-42)

As per claim 65,

Graham et al. discloses the computer program product of Claim 64, wherein said billing information is provided to said processing application electronically via a recordable media. (Column 9, lines 38-42)

Claim 90 is in parallel with claim 65 and are rejected for at least the same reasons.

As per claim 66,

Graham et al. discloses the computer program product of Claim 64, wherein said billing information is provided to said processing application electronically via a communications link. (Column 9, lines 38-42)

Claim 88 is in parallel with claim 66 and are rejected for at least the same reasons.

As per claim 67,

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Graham et al. discloses the computer program product of Claim 66, wherein said communications link comprises said computer network. (Column 9, lines 38-42)

Claim 89 is in parallel with claim 67 and are rejected for at least the same reasons.

Allowable Subject Matter

Claims 41, 44-50, 72-78, 98-105 115,116 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to John Winter whose telephone number is (571) 272-6713. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, James Trammell can be reached at (571) 272-6712. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687
"Box AF"]

[Official communications; including After Final communications labeled

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(703) 308-1396 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the Knox Building, 50
Dulany St. Alexandria, VA.

JMW

November 27, 2005

Dana Rouse
PRIMARY EXAMINER